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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,842	08/24/2001	Jeffrey F. Harper	SCRIP1300-3	1099
7590	03/02/2004		EXAMINER	
Lisa A. Haile, J.D., Ph.D. GRAY CARY WARE & FREIDENRICH LLP 4365 Executive Drive Suite 1100 San Diego, CA 92121-2189			MARTINELL, JAMES	
			ART UNIT	PAPER NUMBER
			1631	
				DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/938,842	HARPER ET AL.
	Examiner	Art Unit
	James Martinell	1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 September 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,29-59,66-70,75 and 80-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 46,58,59,67,68 and 80-86 is/are allowed.
- 6) Claim(s) 1,29,30,32-45,47-57,66,69,70 and 75 is/are rejected.
- 7) Claim(s) 2 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/10/03 & 3/17/03
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 29, 30, 32-45, 47-57, 66, 69, 70, and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague, indefinite, and incomplete.

- (a) The recitation of "representative of expressed polynucleotides in cells of the test plant" (claim 1) is vague and indefinite because it is not clear what sample might or might not be representative. Thus, the metes and bounds of the claims are not clear.
- (b) The recitation of "as compared to a level of selective hybridization obtained using nucleic acid molecules representative of expressed polynucleotides in cells of a plant known not have [sic] been exposed to an abiotic stress" (claim 1) is vague and indefinite because it is not clear what sample might or might not be representative. Thus, the metes and bounds of the claims are not clear.
- (c) The recitation of |polynucleotide portion" (claim 29) is vague and indefinite because no lower limit is set forth for the "portion."
- (d) The recitation of "functional peptide portion thereof" (claims 32, 33, and 34) is vague, indefinite, and incomplete because the instant application does not disclose or define what a functional portion of the peptide is.
- (e) The recitation of "increases the stress tolerance" (claim 33) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.
- (f) The recitation of "decreases the stress tolerance" (claim 34) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.

- (g) The recitation of "stress condition specific for the regulatory element" (claim 38) is vague and indefinite because it is not understood what the term "specific for" means within the context of the claim.
- (h) The recitation of "detectable marker" (claim 41) is vague and indefinite because the instant application does not distinguish between a detectable marker and an undetectable marker.
- (i) The recitation of "altered responsiveness" (claims 43 and 45) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.
- (j) The recitation of "corresponding wild-type plant" (claim 47) is vague and indefinite because the instant application does not distinguish a corresponding plant from a non-corresponding plant.
- (k) The recitation of "reducing or inhibiting expression" (claim 48) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.
- (l) The recitation of "increased tolerance to a stress condition" (claim 49) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.
- (m) The recitation of "decreased tolerance to a stress condition" (claim 50) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.
- (n) The recitation of "improves the nutritional value" (claims 56 and 69) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given. In addition, there is no definition of "improved" in the instant application.

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- (o) The recitation of "improves the . . . ornamental value" (claim 56) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given. In addition, the term "improves" is not defined in the instant application.
- (p) The recitation of "having an altered resistance" (claim 66) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.
- (q) The recitation of "representative of an expressed polynucleotide" (claim 66) is vague and indefinite because it is not clear what sample might or might not be representative. Thus, the metes and bounds of the claims are not clear.
- (r) The recitation of "having a level of expression of a polynucleotide indicative of altered resistance" (claim 66) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given.
- (s) The recitation of "improves the ornamental value" (claim 70) is vague, indefinite, and incomplete because the phrase is comparative and no frame of reference is given. In addition, the term "improves" is not defined in the instant application.
- (t) The recitation of "representative of expressed polynucleotides in plant cells" (claim 75) is vague and indefinite because it is not clear what sample might or might not be representative. Thus, the metes and bounds of the claims are not clear.
- (u) The recitation of "array of probes representative of the plant cell genome" (claim 75) is vague and indefinite because it is not clear what sample might or might not be representative. Thus, the metes and bounds of the claims are not clear.
- (v) The recitation of "polynucleotide involved in a stress response" (claim 75) is vague, indefinite, and incomplete because the instant application does not

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distinguish between an involved polynucleotide and an uninvolved polynucleotide.

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 46, 58, 59, 67, 68, and 80-86 are allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.

PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



**James Martinell, Ph.D.
Primary Examiner
Art Unit 1631**